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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,048	03/31/2000	Christopher Britton Gould	RP9-99-086	4049
25299	7590	07/19/2004	EXAMINER	
IBM CORPORATION PO BOX 12195 DEPT 9CCA, BLDG 002 RESEARCH TRIANGLE PARK, NC 27709			STULBERGER, CAS P	
			ART UNIT	PAPER NUMBER
			2132	8

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/542,048	Applicant(s) GOULD ET AL. 	
	Examiner Cas Stulberger	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: application, filed 3/31/2000; amendment filed 5/06/2004.
2. Claims 1-13 are pending in the case. Claims 1 and 7 are independent claims.

Response to Amendment

3. Applicant's arguments filed 5/06/2004 have been fully considered but they are not persuasive.
4. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.
5. In view of the rejections and response to arguments above, the prior art rejections are maintained. The grounds of rejection as set forth in the previous office action is reproduced below.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,202,151 B1 to Musgrave et al. in view of U.S. Patent No. 6,167,517 to Gilchrist.

In regards to claim 1, 6-8, and 13, Musgrave discloses a biometric certificate which may be generated by concatenating transaction data, a public key, and the set of data, including the biometric data (Musgrave: column 4, lines 53-55). This meets the limitation of "capturing biometric information of a user; encrypting using server public key." The authenticating certificate is then hashed to generate a hashed value. The hashed value is then sent to a registration authority having a biometric certificate generated where the hashed value is then signed; that is, encrypted, using the private key of the user to generate a digital signature incorporating the biometric data. The digital signature is then appended to the transaction data (Musgrave: Column 5, lines 15-35). This meets the limitation of "signing the biometric information with a client private key." After receiving the electronic transaction from the network a receiver decrypts the transaction using it's private key, de-hashes the decrypted transaction and extracts the biometric certificate. The receiver then sends the biometric certificate to the biometric certificate management system (BCMS) for authentication (Musgrave: column 5, lines 36-47). This meets the limitation of " sending the encrypted and signed data to a secure server in the network; accepting and verifying credentials associated with the signed and encrypted data from the server utilizing the public key from the central server."

Musgrave discloses that "since private keys are physically stored on computers and/or electronic storage devices, such private keys are not physically related to the entities associated with the private keys. For example, a private (Musgrave: column 2, lines 40-43)." Since the private key is stored on computers and are physically realted to the devices on which they are

stored on it would be possible to tell from which device a signature using a private key came. Musgrave discloses that "private keys are not limited to actual human individuals (Musgrave: column 2, line 46)." This is interpreted as meaning the private keys can be associated with devices on which they are stored. This meets the limitation of "private key of the computer system." Musgrave also discloses that "after receiving the electronic transaction from the network, a receiver decrypts the electronic transaction using its private key" (Musgrave: column 5, lines 36-38). This meets the limitation of "encrypting the biometric information using a secure server's public key" since in asymmetric cryptography if you decrypt a message with a private key the message must have been encrypted with a the corresponding public key.

However Musgrave does not disclose "installing the credentials into the computer if the credentials are verified."

Gilchrist discloses the biometric template is stored locally on the client system and discloses adding new templates to the system (Gilchrist: column 1, lines 51-65). This meets the limitation of "installing the credentials into the computer if the credentials are verified."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of authentication using a biometric authenticating certificate as disclosed by Musgrave with the method of storing the biometric template locally as disclosed by Gilchrist in order to guard against a malicious user who substitutes another template to gain unauthorized access to the host system (Gilchrist: abstract).

In regards to claim 2 and 9, Musgrave discloses the biometric information comprises fingerprint information (Musgrave: column 4, lines 30-32)

In regards to claim 3 and 10, Musgrave discloses the biometric information comprises retinal information (Musgrave: column 4, lines 30-32)

In regards to claim 4 and 11, Musgrave discloses the biometric information comprises voice information (Musgrave: column 2, lines 47-58)

In regards to claim 5 and 12, Musgrave discloses the biometric information comprises handwritting information (Musgrave: column 4, lines 30-32)

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2132

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cas Stulberger whose telephone number is (703) 305-8034. None. The examiner can normally be reached on Monday - Friday, 9:00A.M. - 5:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications, (703) 746-7240 for drafts, and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

CS

July 13, 2004

Justin T. Darrow
JUSTIN T. DARROW
PRIMARY EXAMINER